

ERW



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: Thomas J. Shaw

Confirmation No.: 8293

Serial No.: 09/617,868

Filing Date: July 17, 2000

Group: 3763

For: SYRINGE PLUNGER  
ASSEMBLY AND BARREL

Examiner: Kevin C. Sirmons

Customer No.: 20873

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**RESPONSE TO NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT  
AFTER EXAMINER ACTION**

In response to a telephone conversation with Examiner Sirmons on April 7, 2005, Applicant files this "Response to Notice of Informal or Non-Responsive Amendment After Examiner Action."

On September 16, 2004, applicant filed a Third Supplemental IDS citing non-patent documents and enclosing copies of the same. In addition, applicant provided as Exhibit A, a list of non-patent documents produced in a related litigation matter for potential consideration by the Examiner, advising that copies would be provided upon

request if the Examiner believed that they were relevant to the prosecution of the referenced application.

On November 17, 2004, the Examiner issued a communication entitled "Information Disclosure Statement" advising applicant that the Third Supplemental Information Disclosure Statement did not comply with 37 CFR § 1.98. This November 17, 2004 communication is attached hereto as Exhibit 1. The communication provided a one-month inextensible response date for correcting omissions in the Third Supplemental Information Disclosure Statement.

The attorney for applicant, Kristen R. Paris, contacted the Examiner on December 17, 2004 regarding the correct format for response to the November 17, 2004 communication and was advised that the Third Supplemental Information Disclosure Statement should be resubmitted providing copies of the references cited in Exhibit A or resubmitted removing Exhibit A and all reference to the same from the document if applicant believed that the references were not relevant to the prosecution of the application.

In compliance with the Examiner's instructions, applicant filed a Revised Third Supplemental Information Disclosure Statement on December 17, 2004 omitting the previously submitted Exhibit A and reference to the same. The Revised Third Supplemental Information Disclosure Statement without copies of the listed prior art references is attached hereto as Exhibit 2. The listed prior art references are not attached because they have been sent to the Office twice, once with the Third Supplemental Information Disclosure Statement filed September 16, 2004 and once with the Revised Third Supplemental Information Disclosure Statement filed on

December 17, 2004.

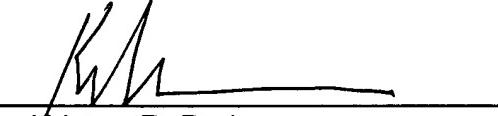
Attorney for applicant contacted the Examiner on April 7, 2005 regarding the status of the referenced application and was advised that further action had not been taken as the response to the November 17, 2004 communication submitted December 17, 2004 was not correctly titled as "Response to Informal or Non-Responsive Amendment." Applicant believes that the Examiner should consider the document filed December 17, 2004 as it was timely filed and titled in accordance with the Examiner's telephone instructions of December 17, 2004. The November 17, 2004 communication received from the Examiner was titled "Information Disclosure Statement" and made no mention of the title "Informal or Non-Responsive Amendment." Furthermore, the Third Supplemental Information Disclosure Statement filed September 16, 2004 was a voluntarily submitted document by applicant under the duty of disclosure under 37 C.F.R. §1.56 and is not considered to be an amendment to the application as filed.

In view of the aforementioned, applicant believes that a timely and correct response has been filed to the Examiner's November 17, 2004 communication and respectfully requests that the Examiner enter the response and consider the references provided by applicant in the Revised Third Supplemental Information Disclosure Statement.

It is believed that no fee is due for the submission of this paper. If this is incorrect, the Commissioner is hereby authorized to charge any fee due to Locke Liddell & Sapp LLP Deposit Account No. 12-1781.

Respectfully submitted,

By:

  
Kristen R. Paris  
Registration No. 52,092

Date: April 25, 2005

LOCKE LIDDELL & SAPP LLP  
2200 Ross Avenue, Ste. 2200  
Dallas, TX 75201-6776  
(214) 740-8678  
(214) 740-8800 (fax)

**DOCKETED**



**UNITED STATES PATENT AND TRADEMARK OFFICE**

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/617,868	07/17/2000	Thomas J. Shaw	75329 77432	8293

20873            7590            11/17/2004  
**LOCKE LIDDELL & SAPP LLP**  
 ATTN: SUE COTT  
 2200 ROSS AVENUE  
 SUITE 2200  
 DALLAS, TX 75201-6776



EXAMINER
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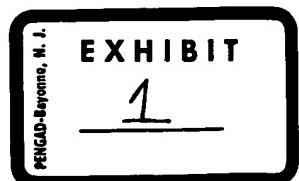
SIRMONS, KEVIN C

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



***Information Disclosure Statement***

The information disclosure statement filed 9/16/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

The information disclosure statement filed on 9/16/04 does not fully comply with the requirements of 37 CFR 1.98 because: It is unclear if applicant wishes the examiner to consider the reference cited during the litigation process, which is disclosed in the IDS. Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above mentioned omissions or corrections in the information disclosure statement. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b). Failure to timely comply with this notice will result in the above mentioned information disclosure statement being placed in the application file with the noncomplying information **not** being considered. See 37 CFR 1.97(i).

***Conclusion***

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kevin C. Sirmons whose telephone number is (703) 306-5410. The examiner can normally be reached on Monday - Thursday from 6:30 am to 4:00 pm. The examiner can also be reached on alternate Fridays.

*Kevin C. Sirmons*

511 272 4965

Kevin C. Sirmons  
Patent Examiner  
11/15/04



75329/77432

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Thomas J. Shaw

Serial No.: 09/617,868

Filing Date: July 17, 2000

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For: SYRINGE PLUNGER  
ASSEMBLY AND BARREL

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**CERTIFICATE OF MAILING**  
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

December 17, 2004

(Date of Mailing)

Kristen R. Paris

(Name of Person Mailing Document)

(Signature)

**REVISED THIRD SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT**

In response to the Office Communication dated November 17, 2004 and a telephone call with the Examiner on December 17, 2004, Applicant submits herewith a revised Third Supplemental Information Disclosure Statement.

This submittal is made in accordance with 37 C.F.R. §§1.97 and 1.98 and §609 of the Manual of Patent Examining Procedure. More particularly, this submittal is made in accordance with 37 C.F.R. §1.97(c). The publications and other information herein are listed on the attached Form PTO/SB/08B. Copies of the listed references on Form PTO/SB/08B are submitted herewith.

Applicant hereby expressly reserves the right to swear behind the effective dates of any of the above publications and to question the relevance and materiality of the



publications listed herein, in whole, in part, or in combination, subsequent to filing this third supplemental information disclosure statement.

In addition, a Power of Attorney executed by the Applicant is enclosed herewith pursuant to a telephone request made by the Examiner on December 17, 2004.

It is believed that no fee is due for the submission of this paper as the fee for the Third Supplemental Information Disclosure Statement was paid on September 15, 2004, when the document was filed. If this is incorrect, the Commissioner is hereby authorized to charge any fee due to Locke Liddell & Sapp LLP Deposit Account No. 12-1781.

Respectfully submitted,

By:



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Kristen R. Paris

Registration No. 52,092

Date: December 17, 2004

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APR 27 2005

PTO/SB/08B (08-03)

Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO

Complete if Known

INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Sheet	1	of	1	Attorney Docket Number	75329/77432
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## NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	1	Memorandum Opinion dated March 2, 2004, Retractable Technologies, Inc. et al. v. New Medical Technology, Inc. et al., cont.	
		No. 4:02-CV-34, U.S. District Court Eastern District, Sherman Division	
	2	Plaintiff Retractable Technologies, Inc. and Third-Party Defendant Thomas J. Shaw's Markman Brief dated February 28, 2003, cont.	
		Retractable Technologies, Inc. et al. v. New Medical Technology, Inc. et al., No. 4:02-CV-34, U.S. District Court Eastern District, Sherman Division	
	3	Defendants' Markman Brief dated March 28, 2003, Retractable Technologies, Inc. et al. v. New Medical Technology, Inc. et al., No. 4:02-CV-34, U.S. District Court, cont.	
		Eastern District, Sherman Division	
	4	Plaintiffs' Markman Reply Brief dated April 14, 2003, Retractable Technologies, Inc. et al. v. New Medical Technology, Inc. et al., No. 4:02-CV-34, U.S. District Court, cont.	
		Eastern District, Sherman Division	
	5	Defendants' Final Invalidity Contentions dated April 21, 2004, Retractable Technologies, Inc. et al. v. New Medical Technology, Inc. et al., No. 4:02-CV-34, cont.	
		U.S. District Court Eastern District, Sherman Division	

Examiner Signature	Date Considered
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



Attorney: KRP/dd  
Title: SYRINGE PLUNGER ASSEMBLY  
AND BARREL  
Applicant: Thomas J. Shaw

Client/Matter No. 75329 / 77432  
Serial No.: 09/617,868  
Today's Date: 12/17/04

**Enclosed for filing in the United States Patent and Trademark Office first class mail are the following:**

1. Revised Third Supplemental Information Disclosure Statement;
2. Copies of cited references;
3. Power of Attorney executed by Applicant; and
4. Postcard acknowledgement.